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No. 87-674

IN THE
SUPREME COURT OF THE UNITED STATES
October Term, 1987

THE MIHALEK CORPORATION and
LAWRENCE PATRICK MIHALEK,

Petitioners,

v.

THE STATE OF MICHIGAN, GOVERNOR
JAMES J. BLANCHARD, THE DEPARTMENT
OF COMMERCE OF THE STATE OF MICHIGAN,
RALPH J. GERSON, DIRECTOR, ROSS ROY, INC.,

Respondents.

ON PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT

RESPONDENTS' BRIEF IN OPPOSITION AND APPENDIX

FRANK J. KELLEY
Attorney General

Louis J. Caruso
Solicitor General
Counsel of Record

Harry G. Iwasko, Jr.
Philip J. Smith
Assistant Attorneys General

Attorneys for Respondents

740 Law Building
525 West Ottawa Street
Lansing, Michigan 48913
Telephone: (517)373-1160

QUESTIONS PRESENTED FOR REVIEW

I.

WHERE THE COURT OF APPEALS DECIDED THIS CASE ON FACTUAL AND STATUTORY BASES AND DID NOT ADDRESS ANY CONSTITUTIONAL ISSUE, SHOULD THIS COURT GRANT CERTIORARI TO DECIDE WHETHER THE COPYRIGHT ACT ABROGATES THE STATE OF MICHIGAN'S ELEVENTH AMENDMENT SOVEREIGN IMMUNITY?

II.

WHERE THE COURT OF APPEALS AND THE DISTRICT COURT APPLIED CORRECT LEGAL STANDARDS TO CLAIMS OF COPYRIGHT INFRINGEMENT, TRADEMARK VIOLATION AND FIFTH AMENDMENT TAKING, SHOULD THIS COURT GRANT CERTIORARI AND EXAMINE THE VOLUMINOUS EVIDENTIARY RECORD IN ORDER TO REVIEW STATUTORY CONCLUSIONS AND FACTUAL FINDINGS UNIQUE TO THESE PARTIES?

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OPINIONS BELOW

The Court of Appeals decision is reported at 814 F2d 290 (CA 6, 1987). The District Court decisions are reported at 595 F Supp 903 (ED Mich, 1984) and 630 F Supp 9 (ED Mich, 1985). An unreported Order and Judgment also appealed is attached as Respondents' Appendix 5b.

STATUTES INVOLVED

The pertinent language of 17 USC 101, *et seq*, is set forth in Respondents' Appendix 19b.

STATEMENT OF THE CASE

The present controversy arises as a result of allegations that Respondents, the State of Michigan and its officials (hereinafter the "State"), stole or otherwise misappropriated the copyrighted works of Petitioners, The Mihalek Corporation and Lawrence P. Mihalek (hereinafter "Mihalek"), in creating, developing and marketing the State's highly successful "Say Yes to

Michigan" promotional campaign.

In 1980, the State of Michigan was in a deep economic recession. The then Governor, William G. Milliken, instructed members of his staff and top State officials to develop a unified, comprehensive promotional program designed to increase national awareness of Michigan's advantages in the area of agriculture, tourism and business. A committee was formed, and presentations were requested from several reputable advertising/ public relations firms, both state and national. (See Respondents' Appendix 11b, Affidavit of former Michigan Governor William G. Milliken, explaining the need for a promotional program and his lack of involvement with Mihalek.) Although the State of Michigan had been promoting itself for over 50 years, the Washington, D.C. public relations firm of Porter, Novelli & Associates was selected in April of 1981 to develop a specific, fresh

promotional campaign. As a result, the "Say Yes to Michigan" campaign was created and subsequently launched during the "Super Bowl" festivities in January of 1982. (See Respondents' Appendix 15b, Affidavit of John H. Porter, detailing how the "Say Yes to Michigan" promotional campaign was created.) In 1984, the Detroit-based advertising firm of Ross Roy, Inc. built upon the "Say Yes to Michigan" theme in developing the "Yes MICHIGAN!" campaign, and more recently the "I Am Michigan" campaign.

In late 1980, Mihalek, who had not previously held himself out as being in the advertising or public relations business, relentlessly hounded various State employees at their homes and offices, in parking lots, and in legislative sessions, in an attempt to impress upon them the value of his own "Michigan is Good News" program. As a courtesy to Mihalek, and at the request of Mihalek's legislative representative, various

State employees met with Mihalek and reviewed his works. For various reasons, the materials, which he subsequently obtained copyright registrations for, were not suitable for the type of promotion the State needed, primarily because they were crude and unimaginative.

Well after the State began its "Say Yes to Michigan" campaign, Mihalek and his counsel began threatening and intimidating state officials and the various media carrying the state-purchased advertising by indicating that the media would be sued if the advertising contracts were fulfilled. In an effort to prevent these unjusified threats from continuing, the State sued Mihalek in state court in April of 1984, claiming an unlawful, intentional interference with the State's economic and contractual relations. Pending a hearing on this claim, a Temporary Restraining Order was entered enjoining Mihalek, "their agents and employees,... from issuing any further threatening

correspondence or communications to the various radio, television, and newspaper mediums."

On the date of the scheduled hearing regarding the State's tort action, Mihalek filed a Complaint in the United States District Court and removed the State action to the Federal Court. Subsequently, a Preliminary Injunction, almost identical to the State entered Temporary Restraining Order, was issued by the District Court in favor of the State.

The State never answered either the original or amended complaint, but first moved for summary judgment denying retroactive monetary damages on the basis of Eleventh Amendment sovereign immunity. The District Court held that the State of Michigan and the Michigan Department of Commerce were absolutely immune from either monetary or equitable relief, and the Governor of the State of Michigan and the Director of the Michigan Department of Commerce could be subject

only to injunctive relief for alleged copyright infringement. *Mihalek Corp, et al* v *State of Michigan, et al*, 595 F Supp 903 (ED Mich, 1984) The Sixth Circuit Court of Appeals did not reach the Eleventh Amendment sovereign immunity issue. *Mihalek Corp, et al* v *State of Michigan, et al*, 814 F2d 290, 297 (CA 6, 1987).

The State and Ross Roy, Inc. (an added party) then moved for a second summary judgment on the copyright count because no substantial similarity existed between Mihalek's and the State's works as a matter of law. After a two and one-half hour informal pre-trial conference scheduled by Mihalek, as well as a two-hour hearing on the State's Motion for Summary Judgment, the District Court, after thoroughly comparing the protected and accused works for several days, found, as a matter of law, on April 17, 1985, that no substantial similarity existed between the respective work products and that, as a matter of

law, no copyright infringement existed. An order was entered by the District Court on April 27, 1985. In a detailed sixteen-page Memorandum Opinion and Order dated June 5, 1985, the District Court denied Mihalek's reconsideration request. *Mihalek Corp, et al* v *State of Michigan, et al*, 630 F Supp 9 (ED Mich, 1985).

Mihalek's alleged copyright claim arises from crude, rough sketches and ideas which comprise Mihalek's proposed campaign to promote Michigan. Mihalek arranged and pasted together photographs of various Michigan scenes and products, labeled them "Michigan is Good News" and had these "works" as well as a slide show depicting similar items copyrighted as the "Michigan is Good News" proposal. Mihalek's proposal also depicts "carrots" and "Mr. Good News" as characters roving throughout the state in a garish van proclaiming the "good news" about Michigan.

The State has never used in its "Say Yes to

Michigan" campaign either the term "Michigan is Good News" or the above-described characters, or any of the crude visual aids or roving van promotional plan allegedly developed by Mihalek. In fact, the State had been promoting its attributes for many years before Mihalek ever came on the scene. Examples of the State's history of advertising were shown to both the Court of Appeals and the District Court as part of the exhibits they examined.

The State moved for a third summary judgment on the remainder of Mihalek's Complaint on April 30, 1985. On November 6, 1985, the District Court, after hearing oral argument, entered an Order and Judgment Granting Summary Judgment in favor of the State on all of Mihalek's Complaint and particularly trademark and the Fifth Amendment. (Order and Judgment, November 6, 1985, p 2. See Respondents' Appendix 5b).

On appeal of these issues, the Court of Appeals

was presented with hundreds of exhibits and some of them have been retained by that Court for post-oral argument review. After examining the materials in the record, including the exhibits, the Court of Appeals agreed with the District Court that no substantial similarity or likelihood of confusion existed between the accused and protected works and no false designation of origin occurred. Furthermore, no evidence of copying or wrongful appropriation was presented. *Mihalek*, 814 F2d at 294-7. The Court of Appeals affirmed the judgment of the District Court that there were no copyright or trademark violations. *Mihalek*, 814 F2d at 295-6. The Court of Appeals did not reach the Eleventh Amendment sovereign immunity issue. *Mihalek*, 814 F2d at 297. On rehearing the Court of Appeals found no error in the District Court's finding of no violation of Petitioners' Fifth Amendment rights, but the Court remanded to the District Court the question of "fair use" of

two photocopies retained by two state employees with the admonition that "there may have been a technical, although possibly *de minimis non curat lex* violation of 17 U.S.C. § 106 ..." (Order, June 6, 1987, p 2, Respondents' Appendix 1b).

REASONS FOR DENYING THE PETITION

I.

THIS COURT SHOULD NOT GRANT CERTIORARI TO DECIDE WHETHER THE COPYRIGHT ACT ABROGATES THE STATE OF MICHIGAN'S ELEVENTH AMENDMENT SOVEREIGN IMMUNITY BECAUSE THE COURT OF APPEALS DECIDED THIS CASE ON FACTUAL AND STATUTORY BASES AND DID NOT ADDRESS ANY CONSTITUTIONAL ISSUE.

A. The Court of Appeals Did Not Reach the Eleventh Amendment Sovereign Immunity Issue.

The Court of Appeals found it unnecessary to reach the Eleventh Amendment sovereign immunity issue because no copyright or trademark infringement existed, (*Mihalek*, 814 F2d at 297), and there was no taking of Petitioners' property under the Fifth Amendment. (Order, June 8, 1987) This Court has held that constitutional decisions should be avoided where a non-constitutional decision can resolve the issue. *Alma Motor Co.* v *Timken-Detroit Axle Co*, 329 US 129, 136 (1946). Furthermore, this Court decides questions of public importance only in the context of meaningful litigation. This Court's function is

judicial, not administrative or managerial, and issues will be resolved only when posed concretely. *Monrosa* v *Carbon Black Export, Inc*, 359 US 180, 184 (1959).

Although the Court of Appeals on rehearing affirmed that there was no taking of Petitioners' property under the Fifth Amendment, that Court remanded to the District Court on the issue of whether Respondents' asserted "fair use" as an affirmative defense to the alleged retention by two state employees of two photocopies, with the specific admonition that there "may have been a technical, although possibly *de minimis non curat lex* violation of 17 USC § 106...." (Order, June 6, 1987, p 2). This remand did not open the door to the Eleventh Amendment sovereign immunity issue simply because there exists no copyright infringement, no trademark violation and no taking under the Fifth Amendment for which monetary relief may result against anyone or anything.

B. Congress Could Not Abrogate a State's Sovereign Immunity by Enacting the Copyright Act Pursuant to Art 1, § 8, cl. 8 of the Constitution.

In describing soverign immunity, Justice Marshall wrote that the federal judicial power granted by the Constitution did not authorize a suit brought by a private party against a state without its consent because of the "fundamental rule" which the Eleventh Amendment exemplified. *Employees* v *Missouri Dept of Public Health and Welfare*, 411 US 279, 291 (1973). The "fundamental rule" is sovereign immunity and it existed prior to the enactment of the Eleventh Amendment. *Accord, Pennhurst State School and Hospital* v *Halderman*, 465 US 89, 98 (1984).

The only clear abrogation of sovereign immunity occurs with laws enacted pursuant to section 5 of the Fourteenth Amendment which limits the power of the Eleventh Amendment. *Atascadero State Hospital, et al* v *Scanlon*, 473 US 234 (1985) at

242-43 and 244-45, n 4. This Court has held that the Fourteenth Amendment is unique and that its provisions are by express terms directed at the states. Enforcement of the Fourteenth Amendment "is no invasion of state sovereignty" and Congress possesses special power when acting pursuant to section 5 of the Fourteenth Amendment. *Fitzpatrick* v *Bitzer*, 427 US 445, 454 (1975).

Although the United States Supreme Court has not decided whether Congress' abrogation authority specifically extends beyond the Fourteenth Amendment [*County of Oneida, New York* v *Oneida Indian Nation of New York State, et al*, 470 US 226, 252 (1985)], for courts to find Congressional abrogation of Eleventh Amendment sovereign immunity whenever Congress legislates would remove the Eleventh Amendment from the Constitution. *Recent Development-Copyright Ingringement: A Doctrine of Unfair Use?* 40 Vand. L. Rev. 225, 267 (1987). This possibility was considered in

Fitzpatrick when this Court stated that Congressional abrogation approved pursuant to the Fourteenth Amendment would be "constitutionally impermissible in other contexts." *Fitzpatrick*, 427 US at 456.

Despite this Court's narrow abrogation holding in *Fitzpatrick*, two cases have held that the states' sovereign immunity was abrogated by the Copyright Act. These were *Mills Music, Inc.* v *Arizona*, 591 F2d 1278 (CA 9, 1979) and *Johnson* v *University of Virginia*, 606 F Supp 321 (W.D. Va, 1985). However, both of these cases were decided prior to *Atascadero* where this Court held that "when acting pursuant to § 5 of the Fourteenth Amendment, Congress can abrogate the Eleventh Amendment without the states' consent." *Atascadero*, 473 US at 238.

In setting forth certain exceptions to the Eleventh Amendment sovereign immunity, this Court in *Welch* v *Texas Dep't of Highways and Public*

Transportation, et al, 483 US ____; 55 USLW 5046 (June 25, 1987) held that waiver by a state of sovereign immunity occurs only with express language or when overwhelmingly implied without any other reasonable construction. 55 USLW at 5048. This Court in *Welch* also affirmed its unwillingness to infer Congressional negation of a states' sovereign immunity because of the 'vital role of the doctrine of sovereign immunity in our federal system.' 55 USLW at 5048.

Since the Copyright Act was enacted by Congress pursuant to Art I, § 8, cl. 8 of the Constitution, there was no abrogation of the states' sovereign immunity.

C. The Copyright Act Did Not Abrogate A State's Sovereign Immunity.

Even if the Copyright Act can be considered to have been enacted pursuant to an appropriate constitutional authority, such as section 5 of the Fourteenth Amendment, the Copyright Act did not

abrogate the state's sovereign immunity.

This Court has held that abrogation requires an "unequivocal expression of congressional intent." *Quern* v *Jordon*, 440 US 332, 342 (1978). More recently, this Court held that "any recipient of federal assistance" included the State of California, but that was insufficient to abrogate the Eleventh Amendment. *Atascadero*, 473 US at 245-46. Not only must Congress express its intent to abrogate the Eleventh Amendment in unmistakable language in the statute itself (*Atascadero*, 473 US at 235), but to subject a state to federal jurisdiction Congress must do so specifically. *Atascadero*, 473 US at 246. Furthermore, this Court requires "an unequivocal expression of Congressional intent to overturn the constitutionally guaranteed immunity of the several States." *Atascadero*, 473 US at 240.

Rather than "express its intention to abrogate the Eleventh Amendment in unmistakable language in

the statute itself," (*Atascadero*, 473 US at 235), Congress undertook a general and vague approach when defining the scope of the Copyright Act. The Copyright Act's authorization in 17 USC § 501(1) to sue 'anyone' who infringes a copyright is not the unequivical statutory language sufficient to abrogate the Eleventh Amendment. *Woelffer* v *Happy States of America*, 626 F Supp 499, 504 (ND Ill, 1985). Therefore, the states have not been specifically included. Instead, 17 USC § 501(1) is simply the general authorization which *Atascadero* rejected as "not the kind of unequivocal statutory language sufficient to abrogate the Eleventh Amendment." *Atascadero*, 473 US at 246.

Furthermore, all of the courts which have decided this copyright/abrogation issue after *Atascadero* have unanimously held that the Copyright Act did not abrogate sovereign immunity. *See*, *Woelffer* v *Happy States of America*, 626 F

Supp 499 (ND Ill, 1985); *Richard Anderson Photography* v *Radford University*, 633 F Supp 1154 (WD Va, 1986) (On appeal to 4th Cir); *Cardinal Industries, Inc* v *Raymond C. King, et al*, 811 F2d 609 (CA 11, 1987) *cert den* ___US___ (1987); and *BV Engineering* v *University of California, Los Angeles*, 657 F Supp 1246 (CD Cal, 1987), (On appeal to 9th Cir). Therefore, no conflict exists among the Courts of Appeals regarding Eleventh Amendment sovereign immunity as a bar to copyright infringement suits against the states. Rather, copyright infringement cases against the states have been consistently decided since *Atascadero*.

Even prior to *Atascadero*, the Court in *Witlow* v *Crow*, 309 F2d 777 (CA 8, 1962), held that the Eleventh Amendment was not abrogated by the Copyright Act. In addition, in *Hercules, Inc* v *Minnesota State Highway Department*, 337 F Supp 795 (DC Minn, 1972), the Court held that the Eleventh Amendment was not abrogated by the Patent Act.

The two copyright cases decided prior to *Atascadero* are both questionable because it was precisely this type of "general authorization to suit in federal court" which *Atascadero* held to be insufficient to abrogate sovereign immunity.

The first case, *Mills Music, Inc* v *Arizona*, 591 F2d 1278 (CA 9, 1979), was recently criticized by a district court in the Ninth Circuit when it held the California Board of Regents immune from suit for copyright infringement in federal court by virtue of the Eleventh Amendment. *BV Engineering* v *University of California, Los Angeles*, 657 F Supp 1246 (CD Cal, 1987) (On appeal to 9th Cir).

The second case, *Johnson* v *University of Virginia*, 606 F Supp 321 (WD Va, 1985), was also decided without the benefit of *Atascadero*, and was premised upon *Mills Music*. In a later case in the same district, a different judge affirmed the state's sovereign immunity and stated that *Johnson*

would have been decided differently under *Atascadero*. *Richard Anderson Photography* v *Radford University*, 633 F Supp 1154, 1160 (WD Va, 1986) (On appeal to 4th Cir).

Therefore, in light of *Atascadero*, neither *Mills Music* nor *Johnson* remain viable because absolutely nothing exists in the Copyright Act to show the unequivocal expression of Congressional intent. If Congress intended to eliminate sovereign immunity, the Copyright Act fails both in its lack of specific unequivocal language and a specific legislative history to support it.

Petitioners suggest at page 35 of their petition that the registration by the states of their copyrights is conditioned upon consent to suit in federal court. However, nothing in 17 U.S.C. § 401-412 contains the necessary unequivocal intent required by *Atascadero*. Respondents' Appendix 30b. Furthermore, Petitioners are clearly wrong at page 42 of their petition when

they assert that certain exemptions in the Copyright Act contain that intent. 17 U.S.C. §§ 108 and 118(d)(3) apply only to non-profit organizations and local governments, entities not protected with Eleventh Amendment sovereign immunity, *Monell* v *Dep't of Social Service*, 436 US 658, 690 (1978) and 17 U.S.C. §§ 601 and 602 protect the importer of materials, not the states. Respondents' Appendix 24b and 28b. Therefore, these sections do not demonstrate that Congress has unequivocally expressed its intent to abrogate Eleventh Amendment sovereign immunity in the Copyright Act.

Furthermore, the Eleventh Amendment does not deal just with *whether* a state can be sued, but it also deals with *where* a state can be sued. The Copyright Act, enacted pursuant to Art I, § 8, cl. 8, deals with remedies. But 28 USC 1338(a) concerns exclusive jurisdiction for copyright claims, *where* a state can be sued, and this

statute was enacted pursuant to Art III, § 2. The Eleventh Amendment is not abrogated by statutes enacted pursuant to Art III. *Pennhurst State School & Hospital* v *Halderman*, 465 US 89, 98 (1984), held that the great significance of the Eleventh Amendment "lies in its affirmation that the fundamental principle of sovereign immunity limits the grant of judicial authority in Art III" of the Constitution. Continuing, the Court in *Pennhurst* stated at page 121 that "...neither pendent jurisdiction nor any other jurisdiction may override the Eleventh Amendment," including exclusive jurisdiction. The teaching of *Pennhurst* then is that the Eleventh Amendment deprives the federal court of the power to decide certain claims by a private party against the state and reduction in a litigant's choice of forum may result. *Pennhurst*, 465 US at 123.

II.

THIS COURT SHOULD NOT GRANT CERTIORARI TO EXAMINE THE VOLUMINOUS EVIDENTIARY RECORD IN ORDER TO REVIEW STATUTORY CONCLUSIONS AND FACTUAL FINDINGS UNIQUE TO THE PARTIES BECAUSE THE COURT OF APPEALS AND THE DISTRICT COURT APPLIED CORRECT LEGAL STANDARDS TO CLAIMS OF COPYRIGHT INFRINGEMENT, TRADEMARK VIOLATION AND FIFTH AMENDMENT TAKING.

A. After Extensive Review of Voluminous Exhibits, Both the Court of Appeals and the District Court Found no Copyright Infringement, Trademark Violation or Taking Under the Fifth Amendment.

The District Court did not determine, nor was it required to determine, whether access to the protected works existed. Disputes as to the access element of copying have no bearing upon a court's finding whether the copyrighted and accused works are substantially similar. The only element of copyright infringement which was decided upon the State's motion was whether substantial similarity existed between Mihalek's and the State's works.

In order to determine substantial similarity

courts have held that they should compare the two works and determine whether as a matter of law a trier of fact would find substantial similarity. *Wickham* v *Knoxville International Energy Exposition*, 739 F2d 1904 (CA 6, 1984). For example, in *Durham Industries, Inc* v *Tomy Corp*, another case in which only the substantial similarity element was at issue, the court stated, "the question of infringement is generally resolved by the fact-finder's prediction of the probable reaction of a hypothetical 'ordinary observer.'" 630 F2d 905, 911 (CA 2, 1980). Furthermore, this comparison by the courts should consider any similarities resulting from depicting a common object and the degree of originality, creativity and independent effort. *Clarke* v *G.A. Kayser & Sons, Inc*, 472 F Supp 481, 482 (WD Pa, 1979), *aff'd without op.*, 631 F2d 725 (CA 3, 1980).

Clearly, it was proper for both the Court of

Appeals and the District Court to examine the works of Mihalek and the State and conclude that no substantial similarity existed. Indeed, it has been held that because the test for substantial similarity involves no more than looking at the two works, the test is ideally suited for summary judgment. *Williams Electronics, Inc* v *Bally Manufacturing Corp*, 568 F Supp 1274 (ND Ill, 1983).

In the instant case, the District Court judge requested that the parties submit to him in advance, all of the evidence on which they were going to rely, and that the exhibits be prepared such that the court would be able to compare similarities between the elements of the accused and protected works. *Mihalek*, 630 F Supp at 14. The District Court examined all of Mihalek's and the State's works for several days prior to the hearing. *Mihalek*, 630 F Supp at 14. The District Court considered whether the similarities resulted from the subject matter, or in this case, the

themes and ideas common to both works.

Both the Court of Appeals and the District Court visually examined both sets of works to determine whether the combination of details created an overall impression of substantial similarity. Both Courts recognized that the test is whether a hypothetical jury could reasonably conclude that the two sets of works were substantially similar. The court, therefore, sets the minimum legal standard for submission to the jury. *Mihalek*, 630 F Supp at 13.

Petitioners' Supplemental Brief dated October 29, 1987, relies on *Baxter* v *MCA, Inc, et al*, 812 F2d 421 (CA 9, 1987) (petition for cert filed) for the proposition that the District Court cannot be the hypothetical jury or lay observer in a summary judgment motion raising the issue of substantial similarity. (Supplemental Brief, p 3). In *Baxter*, the District Court ruled as a matter of law that no substantial similarity

existed. The Court of Appeals reviewed that ruling *de novo*, *Baxter*, 812 F2d at 423, to determine whether any genuine issue of material fact existed sufficient to deny the moving party a judgment as a matter of law. The Court of Appeals recognized that the District Court was correct in ruling on the summary judgment motion:

> "The district court's grant of summary judgment to the defendants must be affirmed if reasonable minds could not differ as to the presence or absence of substantial similarity of expressions." *Baxter*, 812 F2d at 423.

The *Baxter* court reviewed the record and concluded that reasonable minds could differ and summary judgment was inappropriate.

The Court of Appeals in *Mihalek* also reviewed the record and concluded that reasonable minds could not differ and summary judgment was appropriate:

> " ... this Court has itself carefully examined the materials in the record and finds that there are no substantial similarities, ... " *Mihalek*, 814 F2d at 294.

> "We have attempted to duplicate the examination and conclude that there is simply

> no substantial similarities involved in the two public relations programs or campaigns in dispute, and there is no demonstrative evidence of copying or wrongful appropriation of plaintiffs' copyrighted expressions."
> *Mihalek*, 814 F2d at 295.
>
> "After a careful examination of the materials claimed to be protected under the Lanham Act and the particulars involved in the campaigns, we find no error in the findings of the court below."
> *Mihalek*, 814 F2d at 296.

Petitioners' assertion that a conflict exists within the circuits on the appropriate test for substantial similarity is simply wrong.

1. Petitioners' Proposed Affidavits And Additional Testimony Were Legally Inappropriate.

The District Court correctly refused to consider affidavits of persons purported to be "average lay observers" and to consider testimony about substantial similarity.

In *Decorative Aides Corp* v *Staple Sewing Aides*, 497 F Supp 154 (SD NY, 1980), the court granted the defendant's motion for summary judgment

holding that as a matter of law "no reasonable trier of fact could find [the two works] substantially similar." 497 F Supp at 157. The court ruled that in making such a comparison, the works themselves supersede and control any contrary allegations of the parties. *Id. Accord. Shipman* v *R.K.O. Radio Pictures, Inc*, 20 F Supp 249 (SD NY, 1937).

More recently, in *Clarke* v *G.A. Kayser & Sons, Inc*, 472 F Supp 481, 482 (WD Pa, 1979), the court held that summary judgment motions could be decided upon the record because the court had examples of all the relevant articles and packages before it and found no need for testimony on the subject.

Finally, in *Warner Bros, Inc, et al* v *American Broadcasting Companies, Inc, et al*, 720 F2d 231, 245 (CA 2, 1983), the court held that substantial similarity is not a concept familiar to the general public because it is a legal term.

Therefore, when a trial court has ruled that two works are not substantially similar, that conclusion cannot be altered by evidence indicating some people applying some standard of their own believed some similarity existed between the works. Courts, therefore, have the responsibility in copyright cases to set the limits for jury determination.

The Court of Appeals and District Court properly concluded that affidavits and witnesses could not substitute their judgment for the court in order to establish the minimum standard for submission of the case to a jury.

2. The District Court Applied Both Extrinsic and Intrinsic Tests In Finding No Substantial Similarity.

Copyright protects only the expression of ideas, not the ideas themselves. *Wickham* v *Knoxville International Energy Exposition, Inc*, 739 F2d 1094, 1098 (CA 6, 1984). In order to determine

whether a copyright has been infringed, the court must examine the copyrighted material, *Atari, Inc v North American Phillips Consumer Electronics Corp*, 672 F2d 607, 614 (CA 7, 1982), and distinguish similarity of idea or function from similarity of artistic expression. *Durham Industries, Inc v Tomy Corp*, 630 F2d 905, 913 (CA 2, 1980).

Courts have developed tests for distinguishing substantial similarity of copyrightable material from similarity in material not protected by copyright. Indeed, there exists no dispute among the courts as to the definition of these tests.

The test for substantial similarity of *ideas* is the "extrinsic" test. It is objective, *Berkic v Crichton*, 761 F2d 1289, 1292 (CA 9, 1985) and depends upon specific criteria which can be listed and analyzed. *Sid & Marty Krofft Television v McDonalds Corp*, 562 F2d 1157, 1164 (CA 9, 1977).

An "intrinsic" or subjective analysis tests for

similarity of *expression* and considers the total concept and feel of the two works, *Berkic*, 761 F2d at 1292, as determined by an ordinary reasonable person. *Krofft*, 562 F2d at 1164. Using the intrinsic test, the court determines whether any similarities between the works are more than generalized themes. *Warner Bros* v *American Broadcasting Companies, Inc*, 654 F2d 204, 208 (CA 2, 1981).

Mihalek's burden was to show substantial similarity of both ideas and expressions. *Berkic*, 761 F2d at 1292. The District Court correctly identified this burden and conducted a side-by-side examination. *Mihalek*, 630 F Supp at 14. It determined which elements were protected by copyright and concluded that the only similarity existed with things not copyrightable. *Mihalek*, 630 F Supp at 15, 16. The District Court then found no substantial similarity under both tests. *Mihalek*, 630 F Supp at 15. The Court of Appeals

agreed. *Mihalek*, 814 F2d at 294-5.

An additional standard has been used by courts after applying the above tests in order to distinguish copyrightable from non-copyrightable material. Five areas have been held not subject to copyright protection:

1. Matters of historical or contemporary fact;
2. Material traceable to common sources, the public domain, or folk custom;
3. 'Scenes a faire' or incidents, characters or settings indispensable or at least standard in the treatment of a given topic;
4. Clichéd language and metaphors; and
5. Themes or settings.

Alexander v Haley, 460 F Supp 40, 44-6 (SD NY, 1978).

The works at issue in this case have as their objective the promotion of the State of Michigan. Any effective attempt to promote a state must include essential facts such as the state's natural resources, products, recreational

facilities, and matters of pride unique to the state. Also common to plans for promoting a state are clichés which seek to capture an enthusiasm about the state and to instill in people who view the campaigns a positive feeling about the state.

All of the above-described elements for promoting Michigan fall within the standards not subject to copyright protection. Any similarity between Mihalek's and the State's works results from the commonality of non-copyrightable elements. Therefore, the District Court correctly applied the standards of *Alexander* v *Haley* to conclude that no actionable substantial similarity existed. *Mihalek*, 630 F Supp at 13.

In addition, commercial materials require a higher degree of similarity necessary to prove copyright infringement. M. B. Nimmer, *Nimmer on Copyright*, § 143.2 at 631 (1973 ed.) Furthermore, if the originality is very modest more than substantial similarity is necessary. *Id*, § 143.2

n. 107 (Supp 1974).

The works at issue in this case were either proposed (in the case of Mihalek), or used (in the case of the State) as an advertising campaign for the purpose of promoting Michigan. As such, they are all "commercial documents" within Professor Nimmer's definition. Moreover, much of the content of promotional proposals as the one here at issue were dictated by the subject matter being depicted, resulting in little in the way of original expression by Mihalek.

The examination of Mihalek's and the State's works by both the Court of Appeals and the District Court did not support even a minimal finding of substantial similarity. Therefore, a substantial similarity could not exist between the two sets of works.

3. No Confusion To The General Public Existed Between Petitioners' And Respondents' Works.

Mihalek pleads in conclusory language in paragraphs 25 and 26 of the Complaint that the

State falsely attributed Mihalek's work in violation of Section 43(a) of the Lanham Act (15 USC 1125(a)), apparently relying upon the "false designation of origin" language in that section. Mihalek's discussion of these matters before this Court also receives cursory treatment. Petition at p 58.

The test for purposes of determining whether there has been a violation of the prohibition against false designation of origin in Section 43(a) of the Lanham Act is whether or not the accused works are likely to cause confusion to the general public. Courts have consistently held that the "likelihood of confusion" test under 15 USC 1125(a) is the same as that under the Federal Trademark Law in general. *Rolls-Royce Motors, Ltd* v *A&A Fiberglass, Inc*, 428 F Supp 685 (DC Ga, 1977).

In addition, an action based upon false designation of origin will succeed only if the

works copied have acquired a secondary meaning in the marketplace and are non-functional. *Can Am Engineering Co* v *Henderson Glass, Inc*, 620 F Supp 596, 602 (ED Mich, 1985). Mihalek's works never entered the marketplace and they, therefore, could not possibly have acquired the secondary meaning necessary to succeed in a Section 43(a) action.

Furthermore, the "likelihood of confusion" test has been held to be a legal determination, and thus subject to resolution by way of summary judgment. *Alpha Industries, Inc* v *Alpha Steel Tube & Shapes, Inc*, 205 U.S.P.Q. 981 (CA 9, 1980). Summary judgment is therefore appropriate in this case because the issue of likelihood of confusion or deception is a question of law. When the likelihood of confusion or deception does not legally exist, a court may summarily dispose of a case. For example, the Second Circuit Court of Appeals ruled that the likelihood of confusion or deception may be decided as a question of law when

the determination rests on a side-by-side comparison. *Kiki Undies Corp* v *Promenade Hosiery Mills, Inc*, 411 F2d 1097 (CA 2, 1969), *cert den*, 396 US 1054 (1970).

In addition, courts have granted summary judgment when tney determined that the facts were so extreme that no genuine or substantial factual dispute existed. *Wells Fargo & Co* v *Wells Fargo Express Co*, 358 F Supp 1065 (D Nev, 1973), *vacated on other grounds*, 556 F2d 406 (CA 9, 1977).

Indeed, the Court of Appeals and the District Court's finding that there was no substantial similarity on the copyright claim supports its subsequent conclusion that there is no likelihood of confusion to the general public on the trademark claim. In fact, the Ninth Circuit used this analysis when it held that the producers of the motion picture *E.T. - The Extra Terrestrial* were not liable for violating the Lanham Act where there was no substantial similarity between the

two works on the copyright claim. *Litchfield* v *Spielberg*, 736 F2d 1352, 1358 (CA 9, 1984).

Furthermore, in *B&L Sales Associates* v *H. Daroff & Sons, Inc*, 421 F2d 352, 353-4 (CA 2, 1970), the court granted summary judgment and held that affidavits were insufficient to overcome the obvious inference from the exhibits that no consumer could possibly mistake the source of the advertised goods.

Inasmuch as the Court of Appeals and District Court previously ruled that there is no substantial similarity between the works of Mihalek and the State, finding further that the works were, in almost every respect "dissimilar," it must follow that there can be no confusion to the public, as a matter of law.

Even under the broad, sweeping language of Section 43(a) of the Lanham Act, Mihalek has not, and cannot, show a likelihood of reasonable confusion to the public.

4. There Was No Taking of Petitioners' Property Under the Fifth Amendment.

There has been no "taking" or "deprivation" of Mihalek's property by the State. Since it has clearly been determined that no "substantial similarity" exists between the respective work products of the parties and that no likelihood of confusion exists to the general public, it logically follows that there has been no misappropriation of Mihalek's works. If the State had improperly used any of Mihalek's works, such pirating would have manifested itself through a similarity in work products and the likelihood to confuse the general public. Not only did the Court of Appeals and District Court find no substantial similarity between the works of Mihalek and the State, but found as well that the works in almost every respect were "dissimilar". Since there was no substantial similarity for copyright, none can exist for misappropriation of

work product. Callman, *Unfair Comp, Trademark & Monopolies*, (4th Ed), Vol. 1(A), p 111. Common sense dictates that if the work products of Mihalek and the State are "dissimilar", there simply cannot be a justifiable claim of misappropriation of work product and a taking under the Fifth Amendment.

CONCLUSION

WHEREFORE, for all these reasons, Respondents pray that the petition for writ of certiorari be denied.

Respectfully submitted,

FRANK J. KELLEY
Attorney General

Louis J. Caruso
Solicitor General
Counsel of Record
761 Law Building
Lansing, Michigan 48913

Harry G. Iwasko, Jr.
Assistant Attorney General

Philip J. Smith
Assistant Attorney General

Attorneys for Respondents

740 Law Building
525 West Ottawa Street
Lansing, Michigan 48913
Telephone: (517) 373-1160

Dated: November 10, 1987

APPENDIX

APPENDIX

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NOS. 84-1851/1854/85-1593/1986

UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT

THE MIHALEK CORPORATION AND LAWRENCE PATRICK MIHALEK, Plaintiffs-Appellants, v. THE STATE OF MICHIGAN, GOVERNOR JAMES J. BLANCHARD, THE DEPT. OF COMMERCE OF THE STATE OF MICHIGAN, RALPH J. GERSON, DIRECTOR, ROSS ROY, INC., Defendants-Appellees.	)	O R D E R

BEFORE: **MERRITT**, **WELLFORD**, and **NORRIS**, Circuit Judges.

We filed an opinion in this cause on March 18, 1987, affirming the decision of the district court and denying plaintiffs the relief sought for alleged misappropriation of their copyrighted and trademark materials and ideas in the advertising plan in controversy. The petition for rehearing asserts that we failed to reach two issues in our prior opinion. First, the

misappropriation claim included the contention that defendants, through governmental and state action, had taken their property without compensation within the meaning of the fifth amendment. Our opinion does not specifically mention the fifth amendment claim. It is clear, however, that our holding was to the effect that as a matter of law there was no

"taking" of plaintiffs' materials and concepts and those utilized by defendants. We found no error in the district court's conclusion that defendants had not used, appropriated, or benefitted from plaintiffs' property in the form of ideas, materials, or advertising concepts. There was, then, no violation of plaintiffs' claimed fifth amendment rights.

Plaintiffs also assert that we failed to address their claims of "direct photocopying by

defendants" of "copyrighted advertising program plan at the direction of two of the highest officials in the Michigan Department of Commerce." This contention involves the statement made in plaintiffs' brief that two state officials had kept two photocopies of some of the copyrighted material. This photocopying was assertedly discovered during plaintiffs' Michigan Freedom of Information Act investigation following selection by defendants of another advertising program.

It is not clear whether defendants asserted "fair use" as an affirmative defense in this case, nor whether there may have been a technical, although possibly *de minimis non curat lex* violation of 17 U.S.C. § 106 in the alleged retention of photocopies by two state officials. This question was not specifically addressed by the district court in his decision nor does it appear that this failure to address this issue was called to his attention by the parties. We believe it is best for the district court in the

first instance to address this contention. We therefore **REMAND** the question of alleged photocopying by state officials and whether, if it occurred, this constituted a violation of plaintiffs' claimed rights in any respect in light of the record made by the parties.

NOS. 84-1851/1854/85-1593/1986 3

ENTERED BY ORDER OF THE COURT

/s/ John P. Hehman
CLERK

UNITED STATES DISTRICT COURT

FOR THE EASTERN DISTRICT OF MICHIGAN

SOUTHERN DIVISION

THE MIHALEK CORPORATION and
LAWRENCE PATRICK MIHALEK,

Plaintiffs,

No. 84 CV 7202 AA

v

HON. CHARLES W. JOINER

THE STATE OF MICHIGAN, GOVERNOR
JAMES J. BLANCHARD, THE DEPARTMENT
OF COMMERCE OF THE STATE OF MICHIGAN,
RALPH J. GERSON, DIRECTOR, and ROSS
ROY, INC.,

Defendants.

_____/

ORDER AND JUDGMENT
AS TO THE STATE OF MICHIGAN,
GOVERNOR JAMES J. BLANCHARD, THE DEPARTMENT
OF COMMERCE OF THE STATE OF MICHIGAN,
AND RALPH J. GERSON, DIRECTOR

Plaintiffs brought an original cause of action against the State of Michigan, Governor James J. Blanchard, the Department of Commerce of the State of Michigan, and Ralph J. Gerson, Director (hereinafter "state defendants"), based on federal law alleging violations of copyright, trademark and Fifth Amendment; and

Plaintiffs sought to have this Court exercise pendent jurisdiction over state claims against state defendants alleging misappropriation of work product, trade secret and unfair competition; and

Plaintiffs removed to this Court the action entitled *State of Michigan, et al v The Mihalek Corporation, et al*, Livingston County Circuit Court No. 84-7310-CK; and

The state defendants brought various motions in relation to these actions; and

This Court considered the materials submitted by the state defendants, heard oral argument, and being fully advised in the premises; NOW

IT IS ORDERED that, in relation to the original action brought by Plaintiffs against

state defendants in this Court on causes of action based on federal law,

1. The Motion For Summary Judgment in favor of state defendants on the copyright count was granted because, as a matter of law, no substantial similarity exists between the protected works and the accused works.

2. The Motion For Summary Judgment in favor of state defendants on the trademark count is GRANTED because as a matter of law there is and can be no confusion to the general public as to the source and origin of the works.

3. The Motion For Summary Judgment in favor of state defendants on the Fifth Amendment count is GRANTED because there was no taking of Plaintiffs' property.

4. JUDGMENT BE and it hereby is ENTERED in favor of state defendants on all counts setting forth claims based on federal law.

IT IS ORDERED that, in relation to those remaining claims against state defendants in the original action brought in this Court seeking to have this Court exercise pendent jurisdiction against the state, state agencies and state officials in their official capacity, that these remaining claims on the original action brought in this Court are in fact against the State of Michigan, and this Court is barred by the principle of sovereign immunity (11th Amendment) from exercising pendent jurisdiction over these claims, and these claims are DISMISSED WITHOUT PREJUDICE.

IT IS ORDERED that, in relation to the action originated in Livingston County Circuit Court which Plaintiffs (Defendants in the state action) removed to this Court that:

5. The motion by the state defendants for summary judgment on the claims setting forth an

action on copyright, for which this Court has original and exclusive jurisdiction, was GRANTED because as a matter of law, no substantial similarity exists between the protected works and the accused works.

6. JUDGMENT be and it hereby is ENTERED on the federal claims in favor of the state defendants.

7. This Court declines to exercise pendent jurisdiction over claims against state defendants which seek to set forth causes of action under state law, and such remaining claims are REMANDED to the Livingston County Circuit Court.

8. This is a final Judgment and closes the case.

/s/
HONORABLE CHALRES W. JOINER
U. S. District Judge

Dated NOV 6 1985, 1985

UNITED STATES DISTRICT COURT

EASTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION
ANN ARBOR UNIT

JUDGMENT IN A CIVIL CASE

THE MIHALEK CORPORATION
LAWRENCE PATRICK MIHALEK
v.
ROSS ROY, INC.

CASE NUMBER: 84-CV-7202-AA

Jury Verdict. This action came before the Court for a trial by jury. The issues have been tried and the jury has rendered is verdict.

X Decision by Court. This action came to hearing before the Court. The issues have been heard and a decision has been rendered.

IT IS ORDERED AND ADJUDGED

that judgment be and the same is hereby entered in favor of defendant ROSS ROY, INC., and against plaintiffs, THE MIHALEK CORPORATION and LAWRENCE PATRICK MIHALEK, granting defendant's MOTION FOR SUMMARY JUDGMENT in an order dated October 22, 1985.

APPROVED:

/s/
Charles W. Joiner
UNITED STATES DISTRICT JUDGE

NOV 6 1985 — *Date*

ROBERT A. MOSSING — *Clerk*

/s/
(By) Deputy Clerk
JUDITH M. BIRDSALL

UNITED STATES DISTRIT COURT
FOR THE
EASTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION

THE MIHALEK CORPORATION and
LAWRENCE PATRICK MIHALEK,

Plaintiffs,

v

No. 84 CV 7202 AA
HON. CHARLES W. JOINER

THE STATE OF MICHIGAN, GOVERNOR
JAMES J. BLANCHARD, THE DEPARTMENT
OF COMMERCE OF THE STATE OF MICHIGAN,
RALPH J. GERSON, DIRECTOR,

Defendants

_____/

AFFIDAVIT OF WILLIAM G. MILLIKEN

State of Michigan)
) ss
County of Grand Traverse)

WILLIAM G. MILLIKEN, being first duly sworn, deposes and says that he has personal knowledge of the following and that, if sworn as a witness, can testify competently to the facts set forth as follows:

1. From January 1969 to January 1983, I served as Governor of the State of Michigan.

2. During my administration, it was always a priority to promote the State of Michigan. However, in the late 1970's it became even more necessary to vigorously analyze Michigan's business, travel and other conditions, assess those opportunities and receive recommendations to promote those opportunities.

3. To accomplish this assessment, in 1980 I appointed top state executives to work as a committee and report to me. After reviewing proposals from a number of nationally renowned public relation firms, an out-of-state international public relations firm, Porter Novelli Associates, of Washington, D. C., was selected in the spring of 1980 to prepare a marketing and advertising program.

4. Porter Novelli Associates developed the marketing and advertising program, specifically the highly successful "Say Yes to Michigan" theme.

5. I have heard of L. Patrick Mihalek because he sued me in Ingham County Circuit Court seeking mandamus. This case was dismissed in 1982. In addition, I believe one of my aides, Ricchard Schlaff, introduced me to Mr. Mihalek in 1980, while I was walking down a corridor in the State Capitol. The conversation lasted only a few moments and I do not remember anything specific other than greeting him.

6. I have never reviewed any of Mr. Mihalek's material nor have I ever recommended him to anyone, including Lee Iacocca, in writing or orally. I also never instructed any of my staff, including Mr. Schlaff, to recommend him to anyone. I did not write, dictate or have any knowledge of a purported letter to Mr. Iacocca dated November 20, 1980.

/s/
WILLIAM G. MILLIKEN

Subscribed and sworn to before me
this 10th day of April , 1985.

/s/
Virginia A. Moore
Notary Public, Grand Traverse County, MI.
My Commission expires 7/20/86

UNITED STATES DISTRIT COURT
FOR THE
EASTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION

THE MIHALEK CORPORATION AND
LAWRENCE PATRICK MIHALEK,

PLAINTIFFS,

v

No. 84 CV 7202 AA
HON. CHARLES W. JOINER

THE STATE OF MICHIGAN, GOVERNOR
JAMES J. BLANCHARD, THE DEPARTMENT
OF COMMERCE OF THE STATE OF MICHIGAN,
RALPH J. GERSON, DIRECTOR,

DEFENDANTS
_____/

AFFIDAVIT OF JOHN H. PORTER

STATE OF ILLINOIS
COUNTY OF COOK

John H. Porter, being first duly sworn, deposes and says that he has personal knowledge of the following and that if sworn as a witness he can testify competently to the facts herein, as follows:

1. I am Chairman of Needham Porter Novelli of Washington, D.C. and I have held that

position since 1972. Needham Porter Novelli is an international public relations firm with such clients as Campbell Soup Company, the Corporation for Public Broadcasting, and Richardson Vicks.

2. I was first contacted by the State of Michigan in approximately June, 1981 to develop a marketing program to be due in 6 months. Our goal was to promote Michigan tourism and industry. We interviewed 200 people as we developed the background research. I have never met L. Patrick Mihalek nor am I acquainted with any of his materials. My first knowledge of his existence occurred recently arising out of his lawsuit alleging copyright infringement.

3. I met in Lansing, Michigan on September 10, 1981 with the Governor of the State of Michigan to present our proposed campaign.

In the car after the meeting, I came up with the idea of "Say Yes to Michigan". This idea evolved from an advertisement which we had proposed to the Governor to run in the Chicago area. In the advertisement we aked "Is this the best vacation you ever had?" and the reader was asked to mark the ballot "Yes." There was no provision for answering No. There were two Yeses. I realized that the concept of Yes was just what we wanted for the Michigan campaign--for people to say yes to Michigan. Thus, the "Say Yes to Michigan" theme was created.

4. The marketing of the theme was standard marketing practice for the promotion of a state or locality. Similar campaigns had already existed for New York State, Ontario, Canada and the State of Virginia.

/s/
John H. Porter, Chairman

Subscribed and sworn
to before me this 23 day of October 1984.

/s/Philip C. Wilson, Jr.
Notary Public

§ 108. Limitations on exclusive rights: Reproduction by libraries and archives

(a) Notwithstanding the provisions of section 106 [17 USCS § 106], it is not an infringement of copyright for a library or archives, or any of its employees acting within the scope of their employment, to reproduce no more than one copy or phonorecord of a work, or to distribute such copy or phonorecord, under the conditions specified by this section, if--

(1) the reproduction or distribution is made without any purpose of direct or indirect commercial advantage;
(2) the collections of the library or archives are (i) open to the public, or (ii) available not only to researchers affiliated with the library or archives or with the institution of which it is a part, but also to other persons doing research in a specialized field; and
(3) the reproduction or distribution of the work includes a notice of copyright.

(b) The rights of reproduction and distribution under this section apply to a copy or phonorecord of an unpublished work duplicated in facsimile form solely for purposes of preservation and security or for deposit for research use in another library or archives of the type described by clause (2) of subsection (a), if the copy or phonorecord reproduced is currently in the collections of the library or archives.

(c) The right of reproduction under this section applies to a copy or phonorecord of a published work duplicated in facsimile form solely for the purpose of replacement of a copy or phonorecord that is damaged, deteriorating, lost, or stolen, if the library or archives has, after a reasonable effort, determined that an unused replacement cannot be obtained at a fair price.

(d) The rights of reproduction and distribution under this section apply to a copy, made from the collection of a library or archives where the user makes his or her request or from that of another library or archives, of no more than one article or other contribution to a copyrighted collection or periodical issue, or to a copy or phonorecord of a small part of any other copyrighted work, if--

(1) the copy or phonorecord becomes the property of the user, and the library or archives has had no notice that the copy or phonorecord would be used for any purpose other than private study, scholarship, or research; and
(2) the library or archives displays prominently, at the place where orders are accepted, and includes on its order form, a warning of copyright in accordance with requirements that the Register of Copyrights in accordance with requirements that the Register of Copyrights shall prescribe by regulation.

(e) The rights of reproduction and distribution under this section apply to the entire work, or to a substantial part of it, made from the collection of a library or archives where the user makes his or her request or from that of another library or archives, if the library or archives has first determined, on the basis of a reasonable investigation, that a copy or phonorecord of the copyrighted work cannot be obtained at a fair price, if--

(1) the copy or phonorecord becomes the property of the user, and the library or archives has had no notice that the copy or phonorecord would be used for any purpose other than private study, scholarship, or research; and
(2) the library or archives displays prominently, at the place where orders are accepted, and includes on its order form, a warning of copyright in accordance with requirements that the Register of Copyrights shall prescribe by regulation.

(f) Nothing in this section--

(1) shall be construed to impose liability for copyright infringement upon a library or archives or its employees for the unsupervised use of reproducing equipment located on its premises: *Provided*, That such equipment displays a notice that the making of a copy may be subject to the copyright law;
(2) excuses a person who uses such reproducing equipment or who requests a copy or phonorecord under subsection (d) from liability for copyright infringement for any such act, or for any later use of such copy or phonorecord, if it exceeds fair use as provided by section 107 [17 USCS § 107];
(3) shall be construed to limit the reproduction and distribution by lending of a limited number of copies and excerpts by a library or archives of an audiovisual news program, subject to clauses (1), (2), and (3) of subsection (a); or
(4) in any way affects the right of fair use as provided by section 107 [17 USCS § 107], or any contractual obligations assumed at any time by the library or archives when it obtained a copy or phonorecord of a work in its collections.

(g) The rights of reproduction and distribution under this section extend to the isolated and unrelated reproduction or distribution of a single copy or phonorecord of the same material on separate occasions, but do not extend to cases where the library or archives, or its employee--

(1) is aware or has substantial reason to believe that it is engaging in the related or concerted reproduction or distribution of multiple copies or phonorecords of the same material, whether made on one occasion or over a period of time, and whether intended for aggregate use by one or more individuals or for separate use by the individual members of a group; or

(2) engages in the systematic reproduction or distribution of single or multiple copies or phonorecords of material described in subsection (d): *Provided*, That nothing in this clause prevents a library or archives from participating in interlibrary arrangements that do not have, as their purpose or effect, that the library or archives receiving such copies or phonorecords for distribution does so in such aggregate quantities as to substitute for a subscription to or purchase of such work.

(h) The rights of reproduction and distribution under this section do not apply to a musical work, a pictorial, graphic or sculptural work, or a motion picture or other audiovisual work other than an audiovisual work dealing with news, except that no such limitation shall apply with respect to rights granted by subsections (b) and (c), or with respect to pictorial or graphic works published as illustrations, diagrams, or similar adjuncts to works of which copies are reproduced or distributed in accordance with subsections (d) and (e).

(i) Five years from the effective date of this Act, and at five-year intervals thereafter, the Register of Copyrights, after consulting with representatives of authors, book and periodical publishers, and other owners of copyrighted materials, and with representatives of library users and librarians, shall submit to the Congress a report setting forth the extent to which this section has achieved the intended statutory balancing of the rights of creators, and the needs of users. The report should also describe any problems that may have arisen, and present legislative or other recommendations, if warranted.

§ 118. Scope of exclusive rights: Use of certain works in connection with noncommercial broadcasting

(a) The exclusive rights provided by section 106 [17 USCS § 106] shall, with respect to the works specified by subsection (b) and the activities specified by subsection(d), be subject to the conditions and limitations prescribed by this section.

(b) Not later than thirty days after the Copyright Royalty Tribunal has been constituted in accordance with section 802 [17 USCS § 802], the Chairman of the Tribunal shall cause notice to be published in the Federal Register of the initiation of proceedings for the purpose of determining reasonable terms and rates of royalty payments for the activities specified by subsection (d) with respect to published nondramatic musical works and published pictorial, graphic, and sculptural works during a period beginning as provided in clause (3) of this subsection and ending on December 31, 1982. Copyright owners and public broadcasting entities shall negotiate in good faith and cooperate fully with the Tribunal in an effort to reach reasonable and expeditious results. Notwithstanding any provision of the antitrust laws, any owners of copyright in works specified by this subsection and any public broadcasting entities, respectively, may negotiate and agree upon the terms and rates of royalty payments and the proportionate division of fees paid among various copyright owners, and may designate common agents to negotiate, agree to, pay, or receive payments.

(1) Any owner of copyright in a work specified in this subsection or any public broadcasting entity may, within one hundred and twenty days after the publication of the notice specified in this subsection, submit to the Copyright Royalty Tribunal proposed licenses covering such activities with respect to such works. The

Copyright Royalty Tribunal shall proceed on the basis of the proposals submitted to it as well as any other relevant information. The Copyright Royalty Tribunal shall permit any interested party to submit information relevant to such proceedings.

(2) License agreements voluntarily negotiated at any time between one or more copyright owners and one or more public broadcasting entities shall be given effect in lieu of any determination by the Tribunal: *Provided*, That copies of such agreements are filed in the Copyright Office within thirty days of execution in accordance with regulations that the Register of Copyrights shall prescribe.

(3) Within six months, but not earlier than one hundred and twenty days, from the date of publication of the notice specified in this subsection the Copyright Royalty Tribunal shall make a determination and publish in the Federal Register a schedule of rates and terms which, subject to clause (2) of this subsection, shall be binding on all owners of copyright in works specified by this subsection and public broadcasting entities, regardless of whether or not such copyright owners and public broadcasting entities have submitted proposals to the Tribunal. In establishing such rates and terms the Copyright Royalty Tribunal may consider the rates for comparable circumstances under voluntary license agreements negotiated as provided in clause (2) of this subsection. The Copyright Royalty Tribunal shall also establish requirements by which copyright owners may receive reasonable notice of the use of their works under this section, and under which records of such use shall be kept by public broadcasting entities.

(4) With respect to the period beginning on the effective date of this title [17 USCS §§ 101 et seq.] and ending on the date of publication of such rates and terms, this title [17 USCS §§ 101 et seq.] shall not afford to owners of copyright or public broadcasting entities any greater or lesser rights with respect to the activities specified in subsection (d) as applied to works specified in this subsection than those afforded under the law in effect on December 31, 1977, as held applicable and construed by a court in an action brought under this title [17 USCS §§ 101 et seq.].

(c) The initial procedure specified in subsection (b) shall be repeated and concluded between June 30 and December 31, 1982, and at five-year intervals thereafter, in accordance with regulations that the Copyright Royalty Tribunal shall prescribe.

(d) Subject to the transitional provisions of subsection (b)(4), and to the terms of any voluntary license agreements that have been negotiated as provided by subsection (b)(2), a public broadcasting entity may, upon compliance with the provisions of this section, including the rates and terms established by the Copyright Royalty Tribunal under subsection (b)(3), engage in the following activities with respect to published nondramtic musical works and published pictorial, graphic, and sculptural works:

(1) performance or display of work by or in the course of a transmission made by a noncommercial educational broadcast station referred to in subsection (g); and

(2) production of a transmission program, reproduction of copies or phonorecords of such a transmission program, and distribution of such copies or phonorecords, where such production, reproduction, or distribution is made by a nonprofit institution or organization solely for the purpose of transmissions specified in clause (1); and

(3) the making of reproductions by a governmental body or a nonprofit institution of a transmission program simultaneously with its transmission as specified in clause (1), and the performance or display of the contents of such program under the conditions specified by clause (1) of section 110 [17 USCS § 110], but only if the reproductions are used for performances or displays for a period of no more than seven days from the date of the transmission specified in clause (1), and are destroyed before or at the end of such period. No person supplying, in accordance with clause (2), a reproduction of a transmission program to governmental bodies or nonprofit institutions under this clause shall have any liability as a result of failure of such body or institution to destroy such reproduction: *Provided*, That it shall have notified such body or institution of the requirement for such destruction pursuant to this clause: *And provided further*, That if such body or institution itself fails to destroy such reproduction it shall be deemed to have infringed.

(e) Except as expressly provided in this subsection, this section shall have no applicability to works other than those specified in subsection (b).

(1) Owners of copyright in nondramatic literary works and public broadcasting entities may, during the course of voluntary negotiations, agree among themselves, respectively, as to the terms and rates of royalty payments without

liability under the antitrust laws. Any such terms and rates of royalty payments shall be effective upon filing in the Copyright Office, in accordance with regulations that the Register of Copyrights shall prescribe.

(2) On January 3, 1980, the Register of Copyrights, after consulting with authors and other owners of copyright in nondramatic literary works and their representatives, and with public broadcasting entities and their representatives, shall submit to the Congress a report setting forth the extent to which voluntary licensing arrangements have been reached with respect to the use of nondramatic literary works by such broadcast stations. The report should also describe any problems that may have arisen, and present legislative or other recommendations, if warranted.

(f) Nothing in this section shall be construed to permit, beyond the limits of fair use as provided by sectionn 107 [17 USCS § 107], the unauthorized dramatization of a nondramatic musical work, the production of a transmission program drawn to any substantial extent from a published compilation of pictorial, graphic, or sculptural works, or the unauthorized use of any portion of an audiovisual work.

(g) As used in this section, the term "public broadcasting entity" means a noncommercial educational broadcast station as defined in section 397 of title 47 [47 USCS § 397] and any nonprofit institution or organization engaged in the activities described in clause (2) of subsection (d).

§ 501. Infringement of copyright

(a) Anyone who violates any of the exclusive rights of the copyright owner as provided by sections 106 through 118 [17 USCS §§ 106-118], or who imports copies or phonorecords into the United States in violation of section 602 [17 USCS § 602], is an infringer of the copyright.

(b) The legal or beneficial owner of an exclusive right under a copyright is entitled, subject to the requirements of sections 205(d) and 411 [17 USCS §§ 205(d) and 411], to institute an action for any infringement of that particular right committed while he or she is the owner of it. The court may require such owner to serve written notice of the action with a copy of the complaint upon any person shown, by the records of the Copyright Office or otherwise, to have or claim an interest in the copyright, and shall require that such notice be served upon any person whose interest is likely to be affected by a decision in the case. The court may require the joinder, and shall permit the intervention, of any person having or claiming an interest in the copyright.

(c) For any secondary transmission by a cable system that embodies a performance or a display of a work which is actionable as an act of infringement under subsection (c) of section 111 [17 USCS § 111(c)], a television broadcast station holding a copyright or other license to transmit or perform the same version of that work shall, for purposes of subsection (b) of this section, be treated as a legal or beneficial owner if such secondary transmission occurs within the local service area of that television station.

(d) For any secondary transmission by a cable system that is actionable as an act of infringement pursuant to section 111(c)(3) [17 USCS § 111(c)(3)], the following shall also have standing to sue: (i) the primary transmitter whose transmission has been altered by the cable system; and (ii) any broadcast station within whose local service area the secondary transmission occurs.

§ 601. Manufacture, importation, and public distribution of certain copies

(a) Prior to July 1, 1982, and except as provided by subsection (b), the importation into or public distribution in the United States of copies of a work consisting preponderantly of nondramatic literary material that is in the English language and is protected under this title [17 USCS §§ 101 et seq.] is prohibited unless the portions consisting of such material have been manufactured in the United States or Canada.

(b) The provisions of subsection (a) do not apply--

(1) where, on the date when importation is sought or public distribution in the United States is made, the author of any substantial part of such material is neither a national nor a domiciliary of the United States or, if such author is a national of the United States, he or she has been domiciled outside the United States for a continuous period of at least one year immediately preceding that date; in the case of a work made for hire, the exemption provided by this clause does not apply unless a substantial part of the work was prepared for an employer or other person who is not a national or domiciliary of the United States or a domestic corporation or enterprise;

(2) where the United States Customs Service is presented with an import statement issued under the seal of the Copyright Office, in which case a total of no more than two thousand copies of any one such work shall be allowed entry; the import statement shall be issued upon request to the copyright owner or to a person designated by such owner at the time of registration for the work under section 408 [17 USCS § 408] or at any time thereafter;

(3) where importation is sought under the authority or for the use, other than in schools, of the Government of the United States or of any State or political subdivision of a State;
(4) where importation, for use and not for sale, is sought--
(A) by any person with respect to no more than one copy of any work at any one time;
(B) by any person arriving from outside the United States, with respect to copies forming part of such person's personal baggage; or
(C) by an organization operated for scholarly, educational, or religious purposes and not for private gain, with respect to copies intended to form a part of its library;
(5) where the copies are reproduced in raised characters for the use of the blind; or
(6) where, in addition to copies imported under clauses (3) and (4) of this subsection, no more than two thousand copies of any one such work, which have not been manufactured in the United States or Canada, are publicly distributed in the United States; or
(7) where, on the date when importation is sought or public distribution in the United States is made--
(A) the author of any substantial part of such material is an individual and receives compensation for the transfer or license of the right to distribute the work in the United States; and
(B) the first publication of the work has previously taken place outside the United States under a transfer or license granted by such author to a transferee or licensee who was not a national or domiciliary of the United States or a domestic corporation or enterprise; and
(C) there has been no publication of an authorized edition of the work of which the copies were manufactured in the United States; and

(D) the copies were reproduced under a transfer or license granted by such author or by the transferee or licensee of the right of first publication as mentioned in subclause (B), and the transferee or the licensee of the right of reproduction was not a national or domiciliary of the United States or a domestic corporation or enterprise.

(c) The requirement of this section that copies be manufactured in the United States or Canada is satisfied if--

(1) in the case where the copies are printed directly from type that has been set, or directly from plates made from such type, the setting of the type and the making of the plates have been performed in the United States or Canada; or
(2) in the case where the making of plates by a lithographic or photoengraving process is a final or intermediate step preceding the printing of the copies, the making of the plates has been performed in the United States or Canada; and
(3) in any case, the printing or other final process of producing multiple copies and any binding of the copies have been performed in the United States or Canada.

(d) Importation or public distribution of copies in violation of this section does not invalidate protection for a work under this title [17 USCS §§ 601 et seq.]. However, in any civil action or criminal proceeding for infringement of the exclusive rights to reproduce and distribute copies of the work, the infringer has a complete defense with respect to all of the nondramatic literary material comprised in the work and any other parts of the work in which the exclusive rights to reproduce and distribute copies are owned by the same person who owns such exclusive rights in the nondramatic literary material, if the infringer proves--

(1) that copies of the work have been imported into or publicly distributed in the United States in violation of this section by or with the authority of the owner of such exclusive rights; and

(2) that the infringing copies were manufactured in the United States or Canada in accordance with the provisions of subsection (c); and

(3) that the infringement was commenced before the effective date of registration for an authorized edition of the work, the copies of which have been manufactured in the United States or Canada in accordance with the provisions of subsection (c).

(e) In any action for infringement of the exclusive rights to reproduce and distribute copies of a work containing material required by this section to be manufactured in the United States or Canada, the copyright owner shall set forth in the complaint the names of the persons or organizations who performed the processes specified by subsection (c) with respect to that material, and the places where those processes were performed.

§ 602. Infringing importation of copies or phonorecords

(a) Importation into the United States, without the authority of the owner of copyright under this title [17 USCS §§ 101 et seq.], of copies or phonorecords of a work that have been acquired outside the United States is an infringement of the exclusive right to distribute copies or phonorecords under section 106 [17 USCS § 106], actionable under section 501 [17 USCS § 501]. This subsection does not apply to--

(1) importation of copies or phonorecords under the authority or for the use of the Government of the United States or of any State or political subdivision of a State, but not including copies or phonorecords for use in schools, or copies of any audiovisual work imported for purposes other than archival use;

(2) importation, for the private use of the importer and not for distribution, by any person with respect to no more than one copy or phonorecord of any one work at any one time, or by any person arriving from outside the United States with respect to copies or phonorecords forming part of such person's personal baggage; or

(3) importation by or for an organization operated for scholarly, educational, or religious purposes and not for private gain, with respect to no more than one copy of an audiovisual work solely for its archival purposes, and no more than five copies or phonorecords of any other work for its library lending or archival purposes, unless the importation of such copies or phonorecords is part of an activity consisting of systematic reproduction or distribution, engaged in by such organization in violation of the provisions of section 108(g)(2) [17 USCS § 108(g)(2)].

(b) In a case where the making of the copies or phonorecords would have constituted an infringement of copyright if this title [17 USCS §§ 101 et seq.] had been applicable, their importation is prohibited. In a case where the copies or phonorecords were lawfully made, the United States Customs Service has no authority to prevent their importation unless the provisions of section 601 [17 USCS § 601] are applicable. In either case, the Secretary of the Treasury is authorized to prescribe, by regulation, a procedure under which any person claiming an interest in the copyright in a particular work may, upon payment of a specified fee, be entitled to notification by the Customs Service of the importation of articles that appear to be copies or phonorecords of the work.

§ 401. Notice of copyright: Visually perceptible copies

(a) General requirement. Whenever a work protected under this title [17 USCS §§ 101 et seq.] is published in the United States or elsewhere by authority of the copyright owner, a notice of copyright as provided by this section shall be placed on all publicly distributed copies from which the work can be visually perceived, either directly or with the aid of a machine or device.

(b) Form of notice. The notice appearing on the copies shall consist of the following three elements:

(1) the symbol © (the letter C in a circle), or the word "Copyright", or the abbreviation "Copr."; and
(2) the year of first publication of the work; in the case of compilations or derivative works incorporating previously published material, the year date of first publication of the compilation or derivative work is sufficient. The year date may be omitted where a pictorial, graphic, or sculptural work, with accompanying text matter, if any, is reproduced in or on greeting cards, postcards, stationery, jewelry, dolls, toys, or any useful articles; and
(3) the name of the owner of copyright in the work, or an abbreviation by which the name can be recognized, or a generally known alternative designation of the owner.

(c) Position of notice. The notice shall be affixed to the copies in such manner and location as to give reasonable notice of the claim of copyright. The Register of Copyrights shall prescribe by regulation, as examples, specific methods of affixation and positions of the notice on various types of works that will satisfy this requirement, but these specifications shall not be considered exhaustive.

§ 402. Notice of copyright: Phonorecords of sound recordings

(a) General requirement. Whenever a sound recording protected under this title [17 USCS §§ 101 et seq.] is published in the United States or elsewhere by authority of the copyright owner, a notice of copyright as provided by this section shall be placed on all publicly distributed phonorecords of the sound recording.

(b) Form of notice. The notice appearing on the phonorecords shall consist of the following three elements:

(1) the symbol ℗ (the letter P in a circle); and

(2) the year of first publication of the sound recording; and

(3) the name of the owner of copyright in the sound recording, or an abbreviation by which the name can be recognized, or a generally known alternative designation of the owner; if the producer of the sound recording is named on the phonorecord labels or containers, and if no other name appears in conjunction with the notice, the producer's name shall be considered a part of the notice.

(c) Position of notice. The notice shall be placed on the surface of the phonorecord, or on the phonorecord label or container, in such manner and location as to give reasonable notice of the claim of copyright.

§ 403. Notice of copyright: Publications incorporating United States Government works

Whenever a work is published in copies or phonorecords consisting preponderantly of one or more works of the United States Government, the notice of copyright provided by sections 401 or 402 [17 USCS §§ 401 or 402] shall also include a statement identifying, either affirmatively or negatively, those portions of the copies or phonorecords embodying any work or works protected under this title [17 USCS §§ 101 et seq.].

§ 404. Notice of copyright: Contributions to collective works

(a) A separate contribution to a collective work may bear its own notice of copyright, as provided by sections 401 through 403 [17 USCS §§ 401-403]. However, a single notice applicable to the collective work as a whole is sufficient to satisfy the requirements of sections 401 through 403 [17 USCS §§ 401-403] with respect to the separate contributions it contains (not including advertisements inserted on behalf of persons other than the owner of copyright in the collective work), regardless of the ownership of copyright in the contributions and whether or not they have been previously published.

(b) Where the person named in a single notice applicable to a collective work as a whole is not the owner of copyright in a separate contribution that does not bear its own notice, the case is governed by the provisions of section 406(a) [17 USCS § 406(a)].

§ 405. Notice of copyright: Omission of notice

(a) Effect of omission on copyright. The omission of the copyright notice prescribed by sections 401 through 403 [17 USCS §§ 401–403] from copies or phonorecords publicly distributed by authority of the copyright owner does not invalidate the copyright in a work if--

(1) the notice has been omitted from no more than a relatively small number of copies or phonorecords distributed to the public; or
(2) registration for the work has been made before or is made within five years after the publication without notice, and a reasonable effort is made to add notice to all copies or phonorecords that are distributed to the public in the United States after the omission has been discovered; or
(3) the notice has been omitted in violation of an express requirement in writing that, as a condition of the copyright owner's authorization of the public distribution of copies or phonorecords, they bear the prescribed notice.

(b) Effect of omission on innocent infringers. Any person who innocently infringes a copyright, in reliance upon an authorized copy or phonorecord from which the copyright notice has been omitted, incurs no liability for actual or statutory damages under section 504 [17 USCS § 504] for any infringing acts committed before receiving actual notice that registration for the work has been made under section 408 [17 USCS § 408], if such person proves that he or she was misled by the omission of notice. In a suit for infringement in such a case the court may allow or disallow recovery of any of the infringer's profits attributable to the infringement, and may enjoin the continuation of the infringing undertaking or may require, as a condition or permitting the continuation of the infringing undertaking, that the infringer pay the copyright owner a reasonable license fee in an amount and on terms fixed by the court.

(c) Removal of notice. Protection under this title [17 USCS §§ 101 et seq.] is not affected by the removal, destruction, or obliteration of the notice, without the authorization of the copyright owner, from any publicly distributed copies or phonorecords.

§ 406. Notice of copyright: Error in name or date

(a) Error in name. Where the person named in the copyright notice on copies or phonorecords publicly distributed by authority of the copyright owner is not the owner of copyright, the validity and ownership of the copyright are not affected. In such a case, however, any person who innocently begins an undertaking that infringes the copyright has a complete defense to any action for such infringement if such person proves that he or she was misled by the notice and began the undertaking in good faith under a purported transfer or license from the person named therein, unless before the undertaking was begun--

(1) registration for the work had been made in the name of the owner of copyright; or
(2) a document executed by the person named in the notice and showing the ownership of the copyright had been recorded.

The person named in the notice is liable to account to the copyright owner for all receipts from transfers or licenses purportedly made under the copyright by the person named in the notice.

(b) Error in date. When the year date in the notice on copies or phonorecords distributed by authority of the copyright owner is earlier than the year in which publication first occurred, any period computed from the year of first publication under section 302 [17 USCS § 302] is to be computed from the year in the notice. Where the year date is more than one year later than the year in which publication first occurred, the work is considered to have been published without any notice and is governed by the provisions of section 405 [17 USCS § 405].

(c) Omission of name or date. Where copies or phonorecords publicly distributed by authority of the copyright owner contain no name or no date that could reasonably be considered a part of the notice, the work is considered to have been published without any notice and is governed by the provisions of section 405 [17 USCS § 405].

§ 407. Deposit of copies or phonorecords for Library of Congress

(a) Except as provided by subsection (c), and subject to the provisions of subsection (e), the owner of copyright or of the exclusive right of publication in a work published with notice of copyright in the United States shall deposit, within three months after the date of such publication--

(1) two complete copies of the best edition; or
(2) if the work is a sound recording, two complete phonorecords of the best edition, together with any printed or other visually perceptible material published with such phonorecords.

Neither the deposit requirements of this subsection nor the acquisition provisions of subsection (e) are conditions of copyright protection.

(b) The required copies or phonorecords shall be deposited in the Copyright Office for the use or disposition of the Library of Congress. The Register of Copyrights shall, when requested by the depositor and upon payment of the fee prescribed by section 708 [17 USCS § 708], issue a receipt for the deposit.

(c) The Register of Copyrights may be regulation exempt any categories of material from the deposit requirements of this section, or require deposit of only one copy or phonorecord with respect to any categories. Such regulations shall provide either for complete exemption from the deposit requirements of this section, or for alternative forms of deposit aimed at providing a satisfactory archival record of a work without imposing practical or financial hardships on the depositor, where the individual author is the owner of copyright in a pictorial, graphic, or sculptural work and (i) less than five copies of the work have been published, or (ii) the work has been published in a limited edition consisting of numbered copies, the monetary value of which would make the mandatory deposit of two copies of the best edition of the work burdensome, unfair, or unreasonable.

(d) At any time after publication of a work as provided by subsection (a), the Register of Copyrights may make written demand for the required deposit on any of the persons obligated to make the deposit under subsection (a). Unless deposit is made within three months after the demand is received, the person or persons on whom the demand was made are liable--

(1) to a fine of not more than $250 for each work; and
(2) to pay into a specially designated fund in the Library of Congress the total retail price of the copies or phonorecords demanded, or, if no retail price has been fixed, the reasonable cost of the Library of Congress of acquiring them; and
(3) to pay a fine of $2,500, in addition to any fine or liability imposed under clauses (1) and (2), if such person willfully or repeatedly fails or refuses to comply with such a demand.

(e) With respect to transmission programs that have been fixed and transmitted to the public in the United States but have not been published, the Register of Copyrights shall, after consulting with the Librarian of Congress and other interested organizations and officials, establish regulations governing the acquisition, through deposit or otherwise, of copies or phonorecords of such programs for the collections of the Library of Congress.

(1) The Librarian of Congress shall be permitted, under the standards and conditions set forth in such regulations, to make a fixation of a transmission program directly from a transmission to the public, and to reproduce one copy or phonorecord from such fixation for archival purposes.

(2) Such regulations shall also provide standards and procedures by which the Register of Copyrights may make written demand, upon the owner of the right of transmission in the United States, for the deposit of a copy or phonorecord of a specific transmission program. Such deposit may, at the option of the owner of the right of transmission in the United States, be accomplished by gift, by loan for purposes of reproduction, or by sale at a price not to exceed the cost of reproducing and supplying the copy or phonorecord. The regulations established under this clause shall provide reasonable periods of not less than three months for compliance with a demand, and shall allow for extensions of such periods and adjustments in the scope of the demand or the methods for fulfilling it, as reasonably warranted by the circumstances. Willful failure or refusal to comply with the conditions prescribed by such regulations shall subject the owner of the right of transmission in the United States to liability for an amount, not to exceed the cost of reproducing and supplying the copy or phonorecord in question, to be paid into a specially designated fund in the Library of Congress.

(3) Nothing in this subsection shall be construed to require the making or retention, for purposes of deposit, of any copy or phonorecord of an unpublished transmission program, the transmission of which occurs before the receipt of a specific written demand as provided by clause (2).
(4) No activity undertaken in compliance with regulations prescribed under clauses (1) or (2) of this subsection shall result in liability if intended solely to assist in the acquisition of copies or phonorecords under this subsection.

§ 408. Copyright registration in general

(a) Registration permissive. At any time during the subsistence of copyright in any published or unpublished work, the owner of copyright or of any exclusive right in the work may obtain registration of the copyright claim by delivering to the Copyright Office the deposit specified by this section, together with the application and fee specified by sections 409 and 708 [17 USCS §§ 409 and 708]. Subject to the provisions of section 405(a) [17 USCS § 405(a)], such registration is not a condition of copyright protection.

(b) Deposit for copyright registration. Except as provided by subsection (c), the material deposited for registration shall include--

(1) in the case of an unpublished work, one complete copy or phonorecord;
(2) in the case of a published work, two complete copies or phonorecords of the best edition;
(3) in the case of a work first published outside the United States, one complete copy or phonorecord as so published;
(4) in the case of a contribution to a collective work, one complete copy or phonorecord of the best edition of the collective work.

Copies or phonorecords deposited for the Library of Congress under section 407 [17 USCS § 407] may be used to satisfy the deposit provisions of this section, if they are accompanied by the prescribed application and fee, and by any additional identifying material that the Register may, by regulation, require. The Register shall also prescribe regulations establishing requirements under which copies or phonorecords acquired for the Library of Congress under subsection (e) of section 407 [17 USCS § 407(e)], otherwise than by deposit, may be used to satisfy the deposit provisions of this section.

(c) Administrative classification and optional deposit.

(1) The Register of Copyrights is authorized to specify by regulation the administrative classes into which works are to be placed for purposes of deposit and registration, and the nature of the copies or phonorecords to be deposited in the various classes specified. The regulations may require or permit, for particular classes, the deposit of identifying material instead of copies or phonorecords, the deposit of only one copy or phonorecord where two would normally be required, or a single registration for a group of related works. This administrative classification of works has no significance with respect to the subject matter of copyright or the exclusive rights provided by this title [17 USCS § 408].

(2) Without prejudice to the general authority provided under clause (1), the Register of Copyrights shall establish regulations specifically permitting a single registration for a group of works by the same individual author, all first published as contributions to periodicals, including newspapers, within a twelve-month period, on the basis of a single deposit, application, and registration fee, under all of the following conditions--

(A) if each of the works as first published bore a separate copyright notice, and the name of the owner of copyright in the work, or an abbreviation by which the name can be recognized, or a generally known alternative designation of the owner was the same in each notice; and
(B) if the deposit consists of one copy of the entire issue of the periodical, or of the entire section in the case of a newspaper, in which each contribution was first published; and
(C) if the application identifies each work separately, including the periodical containing it and its date of first publication.

(3) As an alternative to separate renewal registrations under subsection (a) of section 304 [17 USCS § 304(a)], a single renewal registration may be made for a group of works by the same individual author, all first published as contributions to periodicals, including newspapers, upon the filing of a single application and fee, under all of the following conditions:

(A) the renewal claimant or claimants, and the basis of claim or claims under section 304(a) [17 USCS § 304(a)], is the same for each of the works; and
(B) the works were all copyrighted upon their first publication, either through separate copyright notice and registration or by virtue of a general copyright notice in the periodical issue as a whole; and
(C) the renewal application and fee are received not more than twenty-eight or less than twenty-seven years after the thirty-first day of December of the calendar year in which all of the works were first published; and
(D) the renewal application identifies each work separately, including the periodical containing it and its date of first publication.

(d) Corrections and amplifications. The Register may also establish, by regulation, formal procedures for the filing of an application for supplementary registration, to correct an error in a copyright registration or to amplify the information given in a registration. Such application shall be accompanied by the fee provided by section 708 [17 USCS § 708], and shall clearly identify the registration to be corrected or amplified. The information contained in a supplementary registration augments but does not supersede that contained in the earlier registration.

(e) Published edition of previously registered work. Registration for the first published edition of a work previously registered in unpublished form may be made even though the work as published is substantially the same as the unpublished version.

§ 409. Application for copyright registration

The application for copyright registration shall be made on a form prescribed by the Register of Copyrights and shall include--

(1) the name and address of the copyright claimant;
(2) in the case of a work other than an anonymous or pseudonymous work, the name and nationality or domicile of the author or authors, and, if one or more of the authors is dead, the dates of their deaths;
(3) if the work is anonymous or pseudonymous, the nationality or domicile of the author or authors;
(4) in the case of a work made for hire, a statement to this effect;
(5) if the copyright claimant is not the author, a brief statement of how the claimant obtained ownership of the copyright;

(6) the title of the work, together with any previous or alternative titles under which the work can be identified;
(7) the year in which creation of the work was completed;
(8) if the work has been published, the date and nation of its first publication;
(9) in the case of a compilation or derivative work, an identification of any preexisting work or works that it is based on or incorporates, and a brief, general statement of the additional material covered by the copyright claim being registered;
(10) in the case of a published work containing material of which copies are required by section 601 [17 USCS § 601] to be manufactured in the United States, the names of the persons or organizations who performed the processes specified by subsection (c) of section 601 [17 USCS § 601(c)] with respect to that material, and the places where those processes were performed; and
(11) any other information regarded by the Register of Copyrights as bearing upon the preparation or identification of the work or the existence, ownership, or duration of the copyright.

§ 410. Registration of claim and issuance of certificate

(a) When, after examination, the Register of Copyrights determines that, in accordance with the provisions of this title [17 USCS §§ 101 et seq.], the material deposited constitutes copyrightable subject matter and that the other legal and formal requirements of this title [17 USCS §§ 101 et seq.] have been met, the Register shall register the claim and issue to the applicant a certificate of registration under the seal of the Copyright Office. The certificate shall contain the information given in the application, together with the number and effective date of the registration.

(b) In any case in which the Register of Copyrights determines that, in accordance with the provisions of this title [17 USCS §§ 101 et seq.], the material deposited does not constitute copyrightable subject matter or that the claim is invalid for any other reason, the Register shall refuse registration and shall notify the applicant in writing of the reasons for such refusal.

(c) In any judicial proceedings the certificate of a registration made before or within five years after first publication of the work shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate. The evidentiary weight to be accorded the certificate of a registration made thereafter shall be within the discretion of the court.

(d) The effective date of a copyright registration is the day on which an application, deposit, and fee, which are later determined by the Register of Copyrights or by a court of competent jurisdiction to be acceptable for registration, have all been received in the Copyright Office.

§ 411. Registration as prerequisite to infringement suit

(a) Subject to the provisions of subsection (b), no action for infringement of the copyright in any work shall be instituted until registration of the copyright claim has been made in accordance with this title [17 USCS §§ 101 et seq.]. In any case, however, where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute an action for infringement if notice thereof, with a copy of the comlaint, is served on the Register of Copyrights. The Register may, at his or her option, become a party to the action with respect to the issue of registrability of the copyright claim by entering an appearance within sixty days after such service, but the Register's failure to become a party shall not deprive the court of jurisdiction to determine that issue.

(b) In the case of a work consisting of sounds, images, or both, the first fixation of which is made simultaneously with its transmission, the copyright owner may, either before or after such fixation takes place, institute an action for infringement under section 501 [17 USCS § 501], fully subject to the remedies provided by sections 502 through 506 and sections 509 and 510 [17 USCS §§ 502-506, 509, 510], if, in accordance with requirements that the Register of Copyrights shall prescribe by regulation, the copyright owner--

(1) serves notice upon the infringer, not less than ten or more than thirty days before such fixation, identifying the work and the specific time and source of its first transmission, and declaring an intention to secure copyright in the work; and
(2) makes registration for the work within three months after its first transmission.

§ 412. Registration as prerequisite to certain remedies for infringement

In any action under this title [17 USCS §§ 101 et seq.], other than an action instituted under section 411(b) [17 USCS § 411(b)], no award of statutory damages or of attorney's fees, as provided by sections 504 and 505 [17 USCS §§ 504 and 505], shall be made for--

(1) any infringement of copyright in an unpublished work commenced before the effective date of its registration; or

(2) any infringement of copyright commenced after first publication of the work and before the effective date of its registration, unless such registration is made within three months after the first publication of the work.